



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Andre ROSENTHAL et al.

Confirmation No.: 8558

Serial No.: 09/930,213

Examiner: Marianne P. Allen

Filed: January 31, 2001

Group Art Unit: 1631

Title: DETECTION OF DIFFERENTIAL GENE EXPRESSIONS

RESPONSE TO REQUIREMENT FOR RESTRICTION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

RECEIVED  
AUG 22 2003  
TECH CENTER 1600/2900

In response to the Restriction Requirement dated April 16, 2003, Applicants hereby elect, with traverse, Group I (claims 1-15) drawn to a nucleic acid and SEQ ID NO:751 (255 nt Rattus sp. DNA).

Applicants submit that the claims, in particular the claims of Groups I-V, relate to nucleic acids that are differentially expressed in tumor cells relative to normal cells. Thus, a search of these claims would be co-extensive, and would not represent a serious search burden for the patent office. Absent a serious burden of examination, restriction is not proper. See M.P.E.P. §803. Thus, the requirement should be withdrawn.

CERTIFICATE OF MAILING

I hereby certify that the correspondence is being deposited with the U.S. Patent and Trademark Office by First Class Mail and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Name: Diana P. M. G.  
Signature: Diana P. M. G.

ALBRE-14

**Declaration**

The examiner has deemed the oath or declaration filed April 26, 2002 defective. Applicants are in the process of having a new declaration executed and will forward same to the Office upon receipt.

**Drawings**

Please delete original figures 11 and 12 without prejudice or disclaimer of the subject matter recited therein.

**Specification**

Please amend page 17 of the specification as follows:

~~Figure 11 shows the nucleotide sequences of cDNAs corresponding to the identified differentially expressed transcripts. In addition to the concretely indicated sequences, Fig. 11 also contains, of course, a disclosure relative to the complementary sequences.~~

~~Figure 12 shows the nucleotide sequences of homologous human cDNAs. Fig. 12 also contains a disclosure relative to the complementary sequences.~~

~~Figure 13 11 shows a correlation of nucleotide sequences (rats) shown in Fig. 11 to the homologous human sequences according to Figure 12 SEQ ID NOS:1-335 and the corresponding T or N clone.~~

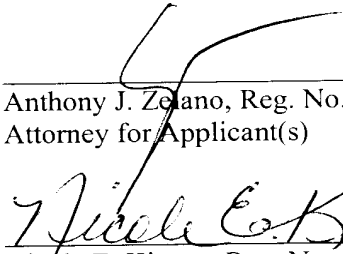
~~SEQ. ID NOS. 1-885; sequences SEQ. ID NOS. 1, 2, 3 ... 335 correspond to sequences 1, 2, 3 ... 335 according to Fig. 12. Sequences SEQ. ID NOS. 336, 337, 338 ... 632 correspond to sequences nos. 1, 2, 3 ... 297 according to Fig. 11, and sequences SEQ. ID NOS. 633, 634, 635 ... 885 correspond to sequences T1, T2, T3 ... T253 according to Fig. 11.~~

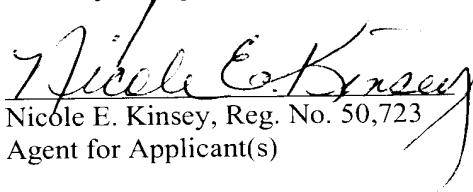
### Sequence Listing

The examiner has stated that the statement under 37 C.F.R. § 1.182(g) is insufficient because it does not state that the paper copy of the sequence listing and the sequence listing on the CRF are identical. A new statement is attached.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

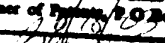
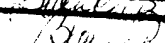
  
Anthony J. Zelano, Reg. No. 27,969  
Attorney for Applicant(s)

  
Nicole E. Kinsey, Reg. No. 50,723  
Agent for Applicant(s)

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza 1, Suite 1400  
2200 Clarendon Boulevard  
Arlington, Virginia 22201  
Telephone: (703) 243-6333  
Facsimile: (703) 243-6410

Date: August 18, 2003  
K:\ALBRE\14\Rsp to RR.doc

### **CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited  
U.S. Postal Service as First Class Mail in an envelope. Address:  
Commissioner of Patents, P.O. Box 1400, Alexandria, VA 22304-1400  
1450 on:   
Name:   
Signature: 